

Appl. No. 10/020,786
Amdt. dated November 14, 2003
Response to Office Action mailed on June 17, 2003

Patent Docket No: P1793R1

REMARKS

Claims 1-27 are pending in this application. Claims 1 and 16 are amended. No new matter is added by the amendments. Support for the amendments is found throughout the specification, such as at page 28, lines 8-9.

With respect to all amendments, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any objection and/or rejection made by the Office. Applicants expressly reserve the right to pursue prosecution of any presently excluded claimed subject matter or embodiments in one or more future continuation and/or divisional applications.

Information Disclosure Statement

The Examiner acknowledged receipt of the information disclosure statements filed 5/24/02 and 7/30/02 (Papers No. 7 & 8, respectively). However, the Examiner contended that the information disclosure statement filed in Paper No. 7 failed to comply with 37 CFR 1.98(a)(2). As Applicants noted in the Communication To Examiner hand delivered to the Office on September 22, 2003, Paper 7 did in fact comply with 37 CFR 1.98(a)(2). Nonetheless, along with the delivery of the Communication, Applicants again provided the Office with a copy of each article listed in PTO Form 1449 of Paper 7.

Applicants respectfully request that an Examiner-initialed copy of said Form 1449 accompany the Office's next communication.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1 and 16 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential elements.

Applicants respectfully traverse.

Applicants note that the specification teaching to which the Examiner refers (specification, page 28, lines 8-11) merely recites one embodiment of the claimed invention. Applicants further respectfully submit that one of skill in the art would recognize that the proteins do not necessarily have to be secreted in order for them to fold properly and form a biologically active immunoglobulin. However, solely in the interest of expediting prosecution, Applicants have herein amended claims 1 and 16 to address the Examiner's concern.

In view of the above, Applicants respectfully request withdrawal of this rejection.

Power Docs #140492

Page 7 of 8

Appl. No. 10/020,786
Amdt. dated November 14, 2003
Response to Office Action mailed on June 17, 2003

Patent Docket No: P1793R1

SUMMARY

Applicants believe that this application is now in condition for immediate allowance and respectfully request that the outstanding rejection be withdrawn and this case passed to issue. No new matter has been introduced, and entry of these amendments is respectfully requested. Reconsideration and further examination of the claims is respectfully requested.

If in the opinion of the Examiner, a **telephone conference** would expedite the prosecution of the instant application, the Examiner is **strongly encouraged** to call the undersigned at the number indicated below.

This response/amendment is submitted with a transmittal letter and petition for a two-month extension of time and fees. In the unlikely event that this document is separated from the transmittal letter or if fees are required, Applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
GENENTECH, INC.

Date: *November 14, 2003*

By: 

Paul Naik, Ph.D.

Reg. No. 49,075

Telephone No. (650) 225-5530